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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,720	10/06/2003	Daniel W. Rodlin	03-110	2871

7590 07/14/2004

LAWRENCE S. COHEN  
SUITE 1220  
10960 WILSHIRE BOULEVARD  
LOS ANGELES, CA 90024

EXAMINER

CANFIELD, ROBERT

ART UNIT PAPER NUMBER

3635

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/679,720	<b>Applicant(s)</b> RODLIN, DANIEL W.	
	<b>Examiner</b> Robert J Canfield	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 17,19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. This is a first Office action on the merits for application serial number 10/679720 filed 10/06/03. Claims 14-17 and 19-22 are pending. Claims 1-13 and 18 have been canceled by preliminary amendment.

2. The new sheet of drawings filed 01/21/04 is accepted.

3. Claims 17 and 19 are objected to because of the following informalities:

Claim 17 depends from canceled claim 6,

In claim 17 "the corner bead" and "its side extensions" lack antecedent basis,

In claim 19 it is unclear which corner bead is being referenced by the language

"the corner bead member" as plural members are defined in claim 15, and

In claim 19 "its side extensions" lack antecedent basis.

Also note that if claim 17 were amended to depend from claim 15 then claims 17 and 19 would be duplicates.

Appropriate correction is required.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 14-17 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,591,566 to Rodlin in view of U.S. Patent 5,625,986 to Mansfield.

Claim 1 of Rodlin provides each of the elements of these claims except for the paper backing fixed to the channel. Mansfield teaches that it was known at the time of the invention to provide paper backings 52, 69, 80, 82, 89 on relief member channels. It would have been obvious at the time of the invention to one having ordinary skill in the art to have provided the channel member of claim 1 of Rodlin with a paper backing as taught by Mansfield to help hold the cementitious material.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,012,203 to Peterson.

Peterson provides bending a sheet metal member into a channel having a top 3, sides 8 and integral corner aids 7 and then applying at least a first layer of cementitious material 12 using aids 7 as guides.

8. Claims 14, 20 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 5,625,986 to Mansfield et al.

The effective filing date of the instant claims is 11/10/97 with the filing of application SN 08/967055. The examiner fails to find support for the instant subject matter in the earlier filed applications.

Mansfield teaches prefabricated relief forms formed from both spot welded woven wire mesh having paper backings 52, 69, 80, 82, 89 (see for example figure 9) and other materials such as expanded metal and the like formed with integral corner aids 77 (see for example figure 11).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,625,986 to Mansfield et al.

Mansfield provides each of the elements/steps of this claim except for specifying that the backing papers 52, 69, 80, 82, 89 are mounted/affixed/or applied with hot glue. Mansfield only states that the backing are mounted or suitably affixed.

The examiner takes Official Notice that one of ordinary skill in the art would have readily recognized hot glue as a suitable means for mounting or affixing the backings of the Mansfield to the channels for its inherent bonding properties and its availability. As such it would have been obvious at the time of the invention to having ordinary skill in the art to have used hot glue as the means for affixing or mounting.

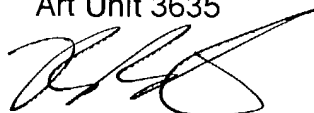
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 703-308-2482. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield  
Primary Examiner  
Art Unit 3635



07/09/04